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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,438	08/15/2003	Roger Moulton	SOU747/4-8US	2478
7590 Thomas W. Adams Renner, Otto, Boisselle & Sklar, L.L.P. Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115			EXAMINER OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/26/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/642,438

Applicant(s)

MOULTON ET AL.

Examiner

Taylor Victor Oh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-7,16,17,22-27,29-34,37,39,41-52 and 57-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,16,17,22-27,29-34,39,41-52 and 57-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/28/06</u> . | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/06 has been entered.

**The Status of Claims :**

Claims 1, 3, 5-7,16-17, 22-27, 29-34,37, 39, 41-52, and 57-65 are pending.

Claims 1, 3, 5-7,16-17, 22-27, 29-34,37, 39, 41-52, and 57-65 have been rejected.

**DETAILED ACTION**

1. Claims 1, 3, 5-7,16-17, 22-27, 29-34,37, 39, 41-52, and 57-65 are under consideration in this Office Action.

**Priority**

2. It is noted that this application claims benefit of 60/404,178 filed on 8/16/2002; claims benefit of 60/404,202 filed on 8/16/2002.

**Drawings**

3. None.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,16-17, 23, 24, 27,30,50, 52, 58, and their corresponding dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1,23-24,27,31,58, the phrases " alkyl or alkenyl groups" and " alkylene group", " heteroarylene group", and " R1 and R2 may be taken together to form a ring" are recited. Each expression of the terms : alkyl , alkenyl , heteroarylene, and the ring is vague and indefinite because the specification does not elaborate what is meant by each term ; there is no definitive carbon atom range for the alkyl , alkenyl and there are no specific heteroatoms for the heteroarylene, and there is no specific ring to be formed.

In claims 23, 30, the phrase " alkylene groups may be further substituted " is recited. This expression is vague and indefinite because in the absence of the specific moieties intended to effectuate modification by the term "substituted", it renders the claim in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional

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language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed. Therefore, an appropriate correction is required.

In claims 16-17, and 50, the term "hydrocarbon" is recited. The expression is vague and indefinite because the specification does not elaborate what is meant by the term "hydrocarbon". The term "hydrocarbon" may mean that a compound consisting of carbon and hydrogen, but there are numerous hydrocarbons known in the organic chemistry; there is uncertainty as to what kind of "hydrocarbon" can be applied for the process. Therefore, an appropriate correction is required.

In claims 52 and 58, the terms "a bis(organo)ester derivative" and "a bis(organoamide)ester derivative" are recited. This expression is vague and indefinite because the specification does not elaborate what is meant by the terms "a bis(organo)ester derivative" and "a bis(organoamide)ester derivative". Therefore, an appropriate correction is required.

In claim 58, the terms "being non-tetrahedrally symmetric" is recited. This expression is vague and indefinite because the specification does not elaborate what is meant by the terms "being non-tetrahedrally symmetric". Therefore, an appropriate correction is required.

In claim 58, the terms "y is greater than 0" are recited. This expression is vague and indefinite because the specification does not elaborate what the upper limit range for y can be for the claim. Therefore, an appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

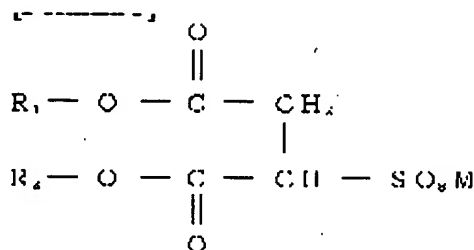
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3, 5-7, 16-17, 22-24, 26-27, 29-31, 33-34, 37, 39, 41-45, 47-48, 50-52, and 57-65 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Kaneko et al (JP08-030013).

Kaneko et al discloses an image removal promoting solution containing the followings (see page 7, formula 3 and 4) :

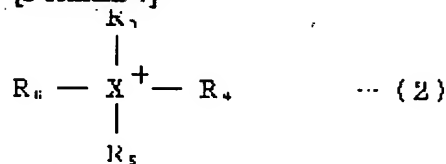
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(The inside of a formula, R1, R2: The same or the alkyl group of the carbon numbers 4-14 which may be different from each other and may branch, M: alkali-metal ion, the 4th class ammonium, the 4th class phosphonium, alkanolamine cation)

When M of a before type (1) furthermore uses the dialkyl sulfo succinate chosen from the group which consists of sodium ion, a lithium ion, the 4th class ammonium shown by the bottom formula (2), the 4th class phosphonium, and an alkanolamine cation, aging of image removal promotion liquid is small, and since the stable removal property is acquired, it is still more desirable.

[Formula 4]



(For the inside of a formula, and X, nitrogen or Lynn, and R3-R6 are hydrogen, the alkyl group of carbon numbers 1-4, a hydroxyalkyl radical, and an alkyl halide radical)

Furthermore, the formula (1-A) (docusate) is represented as a surfactant (see page 8 at the top).

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In order to acquire the removal property of the good image formation matter also in the passage of time, as for the amount of a hydroxide as shown by said formula (2-A) - (2-I), and alkanolamine, it is desirable to be added to the number of mols of a front-type (1) compound, so that it may become 50 % of the weight or more (see page 11, paragraph# 0010).

This is identical with the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Taylor Victor Oh, MSD,LAC

Primary Examiner

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11/30/06

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